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| 10/523,237  | 01/20/2005  | Tiziano Panara         | 19170.010900        | 6509             |
| 34018 7590 05/14/2008<br>GREENBERG TRAURIG, LLP<br>77 WEST WACKER DRIVE<br>SUITE 2500<br>CHICAGO, IL 60601-1732 |             |                        |                     |                  |
| EXAMINER<br>MACASIANO, MARILYN G  |             |                        |                     |                  |
| ART UNIT<br>4137  |             | PAPER NUMBER           |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/523,237

**Applicant(s)**

PANARA, TIZIANO

**Examiner**

MARILYN MACASIANO

**Art Unit**

4137

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 14 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-US)
- Paper No(s)/Mail Date 11/14/2006
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### STATUS OF CLAIMS

1. Claims 1-17 have been examined.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 4 - 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Rakavy et al. (U.S. Patent No. 5,913,040).

As per claim 4, Rakavy et al. discloses a computer-based method of delivering auxiliary content comprising the steps of: receiving over a network a request from a client terminal for the auxiliary content, each item of the auxiliary content having an associated broadcast space comprising a respective time slot (col. 3, lines 4-43 and col. 7- 8, lines 51-3, fig. 4; col. 3, lines 15-33, col. 9, lines 1-7, fig. 4; col. 7-8, lines 51-3 and col. 15, lines 28-42, fig. 10); and selecting one of the items in accordance with a correlation between the broadcast spaces and a

time instant of a request from the client terminal for the auxiliary content (col. 2-3, lines 66-14 and col. 3, lines 52-63).

With respect to claim 5, Rakavy et al. discloses the method according to claim 4, wherein the client terminal is configured to communicate with at least one network resource accessible over the network, the broadcast space is segregated into the time slots and network addresses, and the content selection step comprises selecting the auxiliary content in accordance with a correlation between the broadcast space, and the time instant and a network address of the at least one network resource (col. 3, lines 8-43).

With respect to claim 6, Rakavy et al. discloses the method according to claim 4, wherein the client terminal has a configuration including at least one of a preferred language and a client jurisdiction, the broadcast space is further segregated into advertisement language and advertisement jurisdiction, and the selection step comprises selecting the auxiliary content in accordance with a correlation between the broadcast space and the client configuration (col. 5 - 6, lines 66-3, fig. 2).

With respect to claim 7, Rakavy et al. discloses the method according to claim 4, further comprising the steps of maintaining an advertising broadcast schedule defining the broadcast spaces, and transmitting copies of the advertising broadcast schedule to web servers over the network (col. 5, lines 54-65, fig. 2).

With respect to claim 8, Rakavy et al. discloses a computer-readable medium carrying computing instructions thereon which, when executed on a computing device, causes the computing device to: receive over a network a request from a client terminal for the auxiliary content, each item of the auxiliary content having an associated broadcast space comprising a respective time slot (col. 5, lines 32-37, fig. 2 and col.7, lines 51-61, fig. 4); and select one of the items in accordance with a correlation between the broadcast spaces and a time instant of a request from the client terminal for the auxiliary content (col. 5, lines 45-53, fig. 2).

With respect to claim 9, Rakavy et al. discloses the computer-readable medium according to claim 8, wherein the client terminal is configured to communicate with at least one network resource accessible over the network, the broadcast space is segregated into the time slots and network addresses, and the content selection step comprises selecting the auxiliary content in accordance with a correlation between the broadcast space, and the time instant and a network address of the at least one network resource (col. 5, lines 32-65, fig. 2).

With respect to claim 10, Rakavy et al. discloses the computer-readable medium according to claim 8, wherein the client terminal has a configuration including at least one of a preferred language and a client jurisdiction, the broadcast space is further segregated into advertisement language and advertisement jurisdiction, and the selection step comprises selecting the

auxiliary content in accordance with a correlation between the broadcast space and the client configuration (col. 5 - 6, lines 66-3, fig. 2).

With respect to claim 11, Rakavy et al. discloses the computer-readable medium according to claim 8, further comprising the steps of maintaining an advertising broadcast schedule defining the broadcast spaces, and transmitting copies of the advertising broadcast schedule to web servers over the network (col. 6, lines 9-20, fig. 3).

With respect to claim 12, Rakavy et al. discloses an auxiliary content delivery server comprising: receiving means for receiving over a communications network a request from a client terminal for auxiliary content (col. 3, lines 4-26 and col. 9, lines 17-20); a content database of records each defining an item of the auxiliary content, and a broadcast space for delivery of the associated auxiliary content item, the broadcast space being segregated into time slots (col. 7-8, lines 63-3); content selection means in communication with the receiving means and the content database for selecting the auxiliary content in accordance with a correlation between the broadcast spaces and a time instant of issuance of the request (col. 7, lines 45-61); and delivery means in communication with the content selection means for initiating delivery of the selected content to the client terminal over the network (col. 7, lines 45-61, fig. 4).

With respect to claim 13, Rakavy et al. discloses the auxiliary content delivery server according to claim 12, wherein the client terminal is configured to communicate with at least one network resource accessible over the network, the

broadcast space is segregated into the time slots and network addresses, and the content selection means is configured to select the auxiliary content in accordance with a correlation between the broadcast space, and the time instant and a network address of the at least one network resource (col. 7, lines 45-61, fig. 4).

With respect to claim 14, Rakavy et al. discloses the auxiliary content delivery server according to claim 12, wherein the client terminal has a configuration including at least one of a preferred language and a client jurisdiction, the broadcast space is further segregated into advertisement language and advertisement jurisdiction, and the content selection means is configured to select the auxiliary content in accordance with a correlation between the broadcast space and the client configuration (col. 7-8, lines 63-3).

With respect to claim 15, Rakavy et al. discloses the auxiliary content delivery server according to Claim 12, further configured to maintain statistics of the content delivery (col. 5, lines 32-41, fig. 2).

With respect to claim 16, Rakavy et al. discloses the auxiliary content delivery server according to claim 12, further configured to maintain an advertising broadcast schedule defining the broadcast spaces, and transmit copies of the advertising broadcast schedule to web servers over the network (col. 10, lines 43-52, fig.4).

With respect to claim 17, Rakavy et al. discloses a computer-based method of delivering auxiliary content comprising the steps of: defining a

plurality of broadcast spaces, each said broadcast space comprising a respective time slot for delivery of the auxiliary content over a communications network, and a fee payable for the delivery during the associated time slot (col. 6, lines 31-64, fig. 3); receiving over a network a request from a client terminal for the auxiliary content, each item of the auxiliary content having an associated broadcast space comprising a respective time slot (col. 7, lines 51-61, fig. 4); and selecting one of the items in accordance with a correlation between the broadcast spaces and a time instant of a request from the client terminal for the auxiliary content (col. 7, lines 45-61, fig. 4).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rakavy et al. (U.S. Patent No. 5,913,040) in view of Judson (U.S. Patent No. 5,737,619).

As per claim 1, Rakavy et al. discloses an auxiliary content selection system comprising: a content database of records each defining an item of auxiliary content, and a broadcast space for delivery of the associated auxiliary



content item, the broadcast space being segregated into time slots (col. 3, lines 15-33, col. 9, lines 1-7, fig. 4; col. 7-8, lines 51-3 and col. 15, lines 28-42, fig. 10). While Rakavy et al. teaches the limitation above, Rakavy et al. does not teach the limitation; content selection means in communication with the content database for selecting one of the items in accordance with a correlation between the broadcast spaces and a time instant of a request from a client terminal for the auxiliary content. However, Judson teaches the limitation content selection means in communication with the content database for selecting one of the items in accordance with a correlation between the broadcast spaces and a time instant of a request from a client terminal for the auxiliary content (col. 2, lines 40-53). Therefore it would have been obvious to one of ordinary skill in the art to combine the teachings of Rakavy et al. and Judson in order to serve the ad in an instant.

With respect to claim 2, the combination of Rakavy et al. and Judson teaches the limitation; the auxiliary content selection system according to claim 1, wherein the client terminal is configured to communicate with at least one network resource accessible over a network (Judson; col. 9-10, lines 53-16), the broadcast space is segregated into the time slots and network addresses (Judson; col. 2-3, lines 59- 7), and the content selection means is configured to select the auxiliary content in accordance with a correlation between the broadcast space, and the time instant and a network address of the at least one network resource (Judson; col. 9-10, lines 53 - 2) .

With respect to claim 3, the combination of Rakavy et al. and Judson teaches the auxiliary content selection system according to claim 1, wherein the client terminal has a configuration including at least one of a preferred language and a client jurisdiction (Judson; col. 9, lines 28-52, fig. 11), the broadcast space is further segregated into advertisement language and advertisement jurisdiction (Judson; col. 9-10, lines 53 - 2), and the content selection means is configured to select the auxiliary content in accordance with a correlation between the broadcast space and the client configuration (col. 2-3, lines 59-7).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARILYN MACASIANO whose telephone number is (571)270-5205. The examiner can normally be reached on 5/4/9 7:30-5:00 Mon.-Thur. 7:30-4:00 Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 4137

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

\*\*/M. M./  
Examiner, Art Unit 4137\*

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 4137

